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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/046,592      | 01/14/2002  | R. Michael Gross     |                     | 3738             |

7590 10/06/2005  
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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,592

Applicant(s)

GROSS, R. MICHAEL

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/05 has been entered.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bogert et al. (5810785). Fig. 1d shows a tool having an elongated tube **16** with an outer surface and a proximal end that is capable of being in communication with a suction mechanism. It can also be seen that there is an elongated sleeve **10** and a gasket **26** to the distal end of the sleeve that permits sliding movement of the tube, col. 4, lines 60-63. The gasket is fully capable of sealing engagement with the coracoid process.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by LaBash (5499989). Fig. 3 shows a tool having an elongated tube **30** with an outer surface and a proximal end that is capable of being in communication with a suction mechanism. It

can also be seen there is a sleeve **20** that is slidably coupled to the outer surface of the elongated tube. Additionally, LaBash discloses a sealing surface **24** at the distal end of the sleeve that *is shaped and sized for* sealing engagement with tissue (see Fig. 8g), col. 4, lines 61-63. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of drawing material into a body cavity by forming a negative pressure and suction.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrey et al. (5704909) in view of Bonutti (5403317). Morrey et al. show (Fig. 5) a suction device for engaging bone having an elongated tube **57** and a gasket or disk **81** coupled to the exterior surface of the tube. Morrey discloses the device can be attached to a suction mechanism, col. 4, lines 29-31. Morrey discloses (Fig. 7) the distal end of the tube can have a plurality of openings **66**. However, Morrey et al. fail to disclose a sleeve coupled on the exterior of the tube or the structure of the distal end of the tube. Bonutti teaches that outer sleeves can be slidably placed on the exterior of suction tubes, col. 6, lines 57-59. Bonutti also discloses the outer sleeve acts as a guide for controlling the placement of the device, col. 3, lines 9, 10, 12. Bonutti shows (Fig. 1) the suction tube device **14** has an arcuate distal end. It would have been obvious to one of ordinary skill in the art to use a sleeve and a distal arcuate portion as taught by Bonutti

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with the tool of Morrey et al. such that the surgeon has more control and maneuverability with the tool and less likely to damage tissue when approaching a cavity that is not in the direct path of the tool. It would have been an obvious matter of design choice to modify the distal end to be angular, since applicant has not disclosed that using an angular bend provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the bend of Bonutti incorporated in the Morrey device or the claimed angle bend in claim(s) 4 because both distal ends perform the same function of enabling the surgeon to place the tool within an curved cavity.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrey et al. '909 in view of Bonutti '317 and further in view of Lee et al. (5693030). Morrey et al. in view of Bonutti is explained supra. However, Morrey et al. as modified by Bonutti fail to disclose the tube uses an obturator. Lee teaches (Fig. 3) an obturator **60** that may be extended in the tube that is fully capable of clearing debris. It would have been obvious to one of ordinary skill in the art to permit the tube to be used with an obturator as taught by Lee et al. with the tool of Morrey as modified by Bonutti such that the obturator provides the ability of the surgeon to free up any debris accumulation that would block the flow of material being removed.

***Response to Arguments***

Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO  
PRIMARY EXAMINER**

